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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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GREENBERG TRAUIG, LLP 77 WEST WACKER DRIVE SUITE 2500 CHICAGO, IL 60601-1732				
			EXAMINER SHIMIZU, MATSUICHIRO	
			ART UNIT 2635	PAPER NUMBER

DATE MAILED: 08/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.		Applicant(s)	
	09/615,473		ESCOBOSA ET AL.	
	Examiner		Art Unit	
	Matsuichiro Shimizu		2635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 54-80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 54-62, 64-72 and 74-80 is/are rejected.
- 7) ☒ Claim(s) 63 and 73 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

In response to the Appeal Brief filed on 5/6/05, the examiner withdraws the finality of Final Office Action filed on 2/17/04 in view of new rejection provided to claims 54-62, 64-72 and 74-80.

However, should applicant wish to file another Appeal Brief, the examiner requests the applicant to provide the following correction:

(a) Appendix A needs to be labeled under heading for section VIII of 37 CFR 41.37.

(b) Also Appeal Brief needs a heading for sections IX & X of 37 CFR 41.37 along with a statement of whether or not evidence or decisions exist.

Response to Arguments

After further consideration and newly cited art, Chiloyan is now cited to clearly teach user interaction to determine by experimentation which code set is appropriate for commanding operations.

Therefore, applicant's arguments in the current Appeal Brief with respect to claims *54-62, 64-72 and 74-80* are moot in view of the new grounds of rejection provided by Chiloyan.

Therefore, rejection of claims 54-62, 64-72 and 74-80 follows:

Claim Rejections – 35 USC § 112

Claim 72 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 72 is incomplete for being dependent upon a canceled claim.

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It appears claim 72 as written is intended to depend on claim 71 instead of canceled claim 51, and the examiner prosecutes the claim 72 as such. However, correction of claim 72 to positively define is required.

Claim Rejections – 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 54–56, 58–62, 70–72 and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kemink (WO0017738) in view of Chiloyan et al. (6,008,735).

Regarding claim 54, Kemink teaches a method for selecting function codes for use in a remote control, comprising:

receiving user input at a computer that functions to specify a type of a consumer electronic device (lines 10–20, page 6, a list of appliances associated with graphic interface code to be selected or a plurality of gui corresponding to the

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selected appliance) and a brand (lines 10–15, page 6, graphic display of lists associated with model) of the consumer electronic device;

using the user input at the computer to select a plurality of function code sets that have been identified as being candidates for commanding operations of the specified type of the consumer electronic device and the specified brand of the consumer electronic device; and

causing at least a subset of each of the; plurality of selected function code sets to be downloaded (lines 10–20, page 6, download the selected graphic interface code to the control device 100) from the computer into the remote control whereby a user may interact with the remote control to choose option which one of the plurality of function code sets is appropriate for commanding operations of the specified type of the consumer electronic device and the specified brand of the consumer electronic device (lines 18–22, page 7, user select the option). But Kemink does not specifically teach a user may interact with the remote control to determine by experimentation which one of the plurality of function code sets is appropriate for commanding operations.

However, Chiloyan teaches, in the art of remote control entertainment electronic devices, a user may interact with the remote control to determine by experimentation which one of the plurality of function code sets is appropriate for commanding operations (Figs. 3I–3M, 5, control block 182, col. 7, lines 40–45 and col. 7, line 55 to col. 8, line 14, test different code sets associated with power command for different devices) for the purpose of providing operable device code. Therefore, it would have been obvious to a person skilled in the art at the time the invention was made to include a user may interact with the remote control to determine by

experimentation which one of the plurality of function code sets is appropriate in the device of Kemink because Kemink suggests choosing option which one of the plurality of function code sets is appropriate and Chiloyan teaches a user may interact with the remote control to determine by experimentation which one of the plurality of function code sets is appropriate for commanding operations for the purpose of providing operable device code.

Regarding claim 55, Kemink teaches the method as recited in claim 54, comprising displaying to the user a list (lines 10–20, page 6, a list of appliances associated with graphic interface code to be selected or a plurality of gui corresponding to the selected appliance) comprising a plurality of consumer electronic device types and the user selecting one of the plurality of consumer electronic device types from the list comprises the user input that functions to specify the type of the consumer electronic device (lines 10–20, page 6, a list of appliances associated with user's profile; lines 23–31, page 7, age of user).

Regarding claim 56, Kemink teaches the method as recited in claim 54, comprising displaying to the user a list (lines 10–20, page 6, a list of appliances associated with graphic interface code to be selected or a plurality of gui corresponding to the selected appliance) comprising a plurality of consumer electronic device brands and the user selecting one of the plurality of consumer electronic device brands from the list comprises the user input that functions to specify the brand of the consumer electronic device (lines 10–20, page 6, a list of appliances associated with user's profile).

Regarding claim 58, Kemink in view of Hayes teaches the method as recited in claim 54, comprising arranging the downloaded plurality of function code sets such

that the plurality of function code sets will be tested in an order according to their popularity (lines 1–3, page 6, popularity associated with device control profile–age of user) when the user interacts with the remote control to determine by experimentation which one of the plurality of function code sets is appropriate for commanding operations of the specified type of the consumer electronic device and the specified brand (Kemink–lines 10–15, page 6, graphic display of lists associated with model) of the consumer electronic device (Hayes–col. 4, lines 33–40, experiment with the various device codes and selection of operable device code).

Regarding claim 59, Kemink the method as recited in claim 54, comprising using the one of the plurality of function code sets that is appropriate for commanding operations of the specified type of the consumer electronic device and the specified brand of the consumer electronic device to identify a set of extended function codes (lines 9–12, page 8, choose to combine the function associated with combining icons to expand function codes) for use in commanding extended operations of the specified type of the consumer electronic device and the specified brand of the consumer electronic device (Kemink–lines 10–15, page 6, graphic display of lists associated with model).

Regarding claim 60, Kemink the method as recited in claim 54, wherein the user input is received at the computer via an Internet connection (lines 28–31, page 4, Web associated with internet based service; lines 3–5, page 6, computer associated with the internet access device 210).

Regarding claim 61, Kemink the method as recited in claim 54, wherein the plurality of function code sets are downloaded from the computer directly into the remote control (Fig. 2, computer 210 to remote controller 100).

Regarding claim 62, Kemink the method as recited in claim 54, comprising displaying to the user a key layout for the remote control and a list of functions from the function code set appropriate for commanding operations of the specified type (lines 25–27, device for the age of user) of the consumer electronic device and the specified brand of the consumer electronic device (lines 13–15, page 6, special model number) and accepting user input to assign functions from the list of functions to the key layout, assignments of functions to the key layout being downloadable from the computer to the remote control (lines 29–33, page 4, downloaded GUI is configurable by dragging icons over the screen) to thereby configure the remote control to command operations of the specified type of the consumer electronic device and the specified brand of consumer electronic device.

Regarding claim 70, Kemink the method as recited in claim 54, wherein the plurality of function code sets each comprise codes for driving an IR emitting diode of the remote control (lines 19–20, page 6, IR transmitter 100).

All subject matters in claim 71 are disclosed in claims 54–56, 60 and 62, therefore rejection of the subject matters expressed in claim 71 are met by references and associated arguments applied to rejection of claims 54–56, 60 and 62.

All subject matters in claims 72 and 80 are disclosed in claims 58 and 70, therefore rejection of the subject matters expressed in claims 72 and 80 are met by references and associated arguments applied to rejection of claims 58 and 70.

Claims 57 and 64–69 and 74–79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kemink (WO0017738) in view of Chiloyan as applied to claims 54, 62 and 71 above, and further in view of Foster (6,211,870).

Regarding claims 57 and 64–69, Kemink teaches the method as recited in claims 54 and 62, comprising presenting a graphical user interface (lines 10–20, page 6, GUI); the specified type of the consumer electronic device and the specified brand of the consumer electronic device (lines 13–15, page 6, special model number). But Kemink in view of Chiloyan does not teach a graphical user interface having drag and drop capabilities for use in assigning functions from the list of functions to the key layout; a speaker assignments of function codes to the key layout; a memory card assignments of functions to the key layout; keys displayable in a display of the remote control; a power operation.

However, Foster teaches, in the art of graphic user interface system, a graphical user interface having drag and drop capabilities for use in assigning functions from the list of functions to the key layout (Fig. 11, drag and drop from the list 114); a speaker assignments of function codes to the key layout (Fig. 9, speaker assignment associated with vol– and vol+ keys); keys displayable in a display of the remote control (Fig. 9, display area 721); a power operation (Fig. 9, power button on display 721); a memory card assignments of functions to the key layout for the purpose of providing enhanced user–friendly system. Therefore, it would have been obvious to a person skilled in the art at the time the invention was made to include a graphical user interface having drag and drop capabilities for use in assigning functions from the list of functions to the key layout; a speaker assignments of function codes to the key layout; keys displayable in a display of the remote control; a power operation; and a memory card assignments of functions to the key layout in the device of Kemink in view of Chiloyan because Kemink in view of Chiloyan suggests a graphical user interface and Foster teaches a graphical user interface having drag and

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drop capabilities for use in assigning functions from the list of functions to the key layout; a speaker assignments of function codes to the key layout; keys displayable in a display of the remote control; a power operation; and a memory card assignments of functions to the key layout for the purpose of providing user-friendly system.

All subject matters in claims 74-79 are disclosed in claims 60, 64-70, therefore rejection of the subject matters expressed in claims 74-79 are met by references and associated arguments applied to rejection of claims 60 and 64-70.

Allowable Subject Matter

Claims 63 and 73 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claims 63 and 73, the prior arts fail to teach or fairly suggest displaying an amount of memory needed in the remote control to download from the computer to the remote control assignments of functions to the key layout.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

O'Donnell et al., Universal Remote Control Method And Apparatus, US 6,549,143, 4/15/2003.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matsuichiro Shimizu whose telephone number is (571-272-3066). The examiner can normally be reached on Monday through Friday from 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik, can be reached on (571-272-3068). The fax phone number for the organization where this application or proceeding is assigned is (703-305-3988).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703-305-8576).

Matsuichiro Shimizu

August 17, 2005



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